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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,990	07/30/2003	Walter W. Lenox	RM507a	7725
23996	7590	08/12/2005	EXAMINER	
RICK MARTIN PATENT LAW OFFICES OF RICK MARTIN, PC 416 COFFMAN STREET LONGMONT, CO 80501			SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/630,990	LENOX, WALTER W.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dmitry Suhol	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 is/are allowed.
- 6) ☒ Claim(s) 11-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/5/05, 7/30/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-31 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. US 6,601,616 in view of Czebatul et al '467. Although the conflicting claims are not identical, they are not patentably distinct from each other because Patent '616 discloses all of the claimed limitations but for a manual release lever for each of the first and second gripper as required by claim 1 and an automated clamp release mechanism which releases the clamp segment after the powered cutter cuts the clamp segment as required by claims 11 and 23. However, providing manual release levers would have been obvious since the examiner takes official notice that such controls are notoriously well known in the art and utilized for purposes such a clearing jams, making adjustments or introducing the clamps into the device. Additionally, automated release

mechanism are known to be provided with such tools as evidenced by Czebatul in cols. 11-12, lines 66+ and 1-10, respectively as ejection assembly 54.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-12 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Czebatul et al '467. Czebatul discloses a clamp applicator containing all of the claimed elements including with reference to claims 11 and 23, a housing having a motor (housing of motor 72), a powered pulling member having a clamp which removably attaches to a clamp segment (figures 8-10 and col. 14, lines 5-7), an automated clamp release mechanism which releases the clamp segment after the powered cutter cuts the clamp segment (ejection assembly 54, cols. 11-12, lines 66+ and 1-10, respectively). A screw (180) powered housing (266) containing an angled slot (slot defined by the opening of housing 266) with a movable jaw therein (jaw 238), as required by claim 12, is shown in figures 4 and 7.

Claims 23 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Dyer et al '133. Dyer discloses a clamp applicator containing all of the claimed elements including, a housing having a motor (figure 11, element 20), a clamp entry port (slot 50), a pulling member means (gripper 54 and plate 56), a cutter means (cutoff mechanism 36) and an automatic clamp release means (col. 6, lines 1-4). A variable torque transmission means, as required by claim 28, is shown as dial 38 in figure 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-17, 26, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Czebatul et al '467 in view of Hidassay '011. Although Czebatul discloses most of the claimed elements, as stated above, and further including that the motor 72 is a DC type motor (col. 7, lines 12-13) as required by claim 16, and a bench mount (figure 3) and a foot switch (126) as required by claims 17 and 29, the reference fails to explicitly teach a battery pack as required by claim 16, a AC-DC converter and a DC input port on the housing as required by claims 17 and 29. However, Hidassay discloses a tool for applying clamp ties which teaches that such tools are known to be provided with an AC-DC converter and battery packs for the purposes of providing various power sources to the tool. Therefore it would have been obvious to one having ordinary skill in the art, at

the time of the claimed invention, to have provided the tool of Czebatul with an AC-DC converter and battery packs for the purposes of providing various power sources to the tool.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dyer et al '133 in view of Dyer et al '290. Dyer '133 lacks the explicit teaching that clamp adapter (headpiece 46) is removably attachable as required by claim 27. However Dyer '290 discloses a device like that of Dyer '133 which teaches that it is know to construct such devices with headpieces which are removably attachable (figure 3). Therefore it would have been obvious to provide a removable attachment means for the headpiece of Dyer '133 for the purpose of being able to replace the headpiece as desired.

#### ***Allowable Subject Matter***

Claims 1-10 are allowed.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol  
Examiner  
Art Unit 3725

ds